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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,434	03/15/2002	Georg Schofberger	1999CHO23	9148

25255 7590 05/12/2003

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

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DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

Office Action Summary	Application No. 10/088,434	Applicant(s) SCHOFBERGER ET AL.	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Information Disclosure Statement filed 6/28/2002 contains there references which have no date thus are not in conformance with MPEP 609. Applicant is requested to provide dates for references CB, CC and CD in response to this action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clariant, WO 98/554264 (equivalent to US 6,210,448) or Clariant, WO 98/58025 (equivalent to US 6,309,427) in view of Erbsloeh, DE 3641766, English language abstract (CA on IDS of 6/28/2002). The US equivalents will be used for the citations below.

US 6,210,448 discloses chromium complex anionic dyes having sulfonate groups which are useful for dyeing oxide aluminum or aluminum alloy layers. The dyeing process is an aqueous one as claimed, followed by rinsing and sealing as claimed. The sealing may be a one or two step process as claimed. Cold sealing at 20-30°C. with nickel salts in combination with fluoride ions as claimed is disclosed at the top of column 8. The oxide layers may also be hot sealed with water as claimed. See Application Example A in column 11 lines 1 et seq. for the dyeing process using an aqueous dyebath and then rinsing with water and sealing; and col 7 line 65 to col 8 line 4 for the

sealing processes. US 6,309,427 contains the same disclosure; see col 7 line 48 to col 8 line 16 for the sealing procedure and Application example A in col 12 lines 26 et seq. for the aqueous dyeing and rinsing procedure, followed by sealing. In Application example A, patentees disclose alternative sealing procedures of sealing with a composition comprising a nickel acetate salt or sealing in deionized water at 98-110° C. Accordingly, the Clariant references teach all of the limitations of applicant's claimed process. They differ from the claims in that they do not provide a working example of dyeing with nickel fluoride, or of using the two different sealing procedures sequentially as claimed in claim 2.

Erbsloeh is applied for his teaching of sealing of dyed oxidized aluminum or aluminum alloy layers with a two step procedure as claimed in instant claim 2: first with nickel ions and fluoride ions and then with hot water or steam.

It would have been obvious to the skilled artisan to seal the dyeings in the Clariant references with a preparation comprising nickel ions and fluoride ions by a cold sealing method as claimed in claim 1 because Clariant clearly discloses that alternative in the places cited above. It would have been obvious to then further seal with water in a hot sealing process for the additional benefits it provides, because such sealing is also taught by both references. Additionally, Clariant teaches in '427 col 7 last paragraph that sealing may be accomplished in a hot sealing method with water, and "in a further procedure" with metal salts, and then includes the claimed NiF as a metal salt. By teaching a further procedure, patentee discloses that two procedures may be used sequentially for sealing. Patentee states that such sealing with metal salts

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permits particularly effective suppression of dye bleeding, giving further motivation to seal with salts in addition to hot water. It would have been obvious to the skilled artisan to seal with the nickel and fluoride ions and then to seal with a hot water and/or ^{steam}stem since that is the procedure and sequence of steps taught for sealing dyed oxidized aluminum layers by Erbsloeh. See abstract.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 3, 6, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Clariant, WO 98/54264. Using the US equivalent, 6,210,448 for the citations, Clariant discloses a process as claimed in claim 1 wherein aluminum oxide layers and alloys thereof are dyed from an aqueous dyebath by anionic dyes capable of forming Ni complexes with Ni ions and sealed, the sealing being carried out by a sealing agent containing Ni ions and fluoride ions. Noting the application examples, the dyeings are carried out in an aqueous dyebath; the sealing carried out with NiF is disclosed in col 8 lines 1-4. Regarding the limitation of claim 3, see Table 2 in col 12 where the comparative examples had low fastness ratings.

The above rejection may also be made over WO 98/58025 but would be cumulative to the above rejection.

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Claims 6-10 are rejected under 35 U.S.C. 103 as obvious over or 102(b) as being anticipated by Clariant, WO 98/58025 or WO 98/56264. The dyed oxide layers disclosed in Table 2 of each reference anticipate these claims. Dyed oxide layers having lightfastness of 6-11 are disclosed on both tables. The subject matter would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See *In re Thorpe*, 227 USPQ 964 (CAFC 1985); *In re Marosi et al*, 218 USPQ 289; *In re Pilkington*, 162 USPQ 145.

"The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972).

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba Ltd, GB 703949 in view of Clariant. 6,210,448. Ciba discloses a process as

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claimed in claim 1 wherein aluminum oxide layers are dyed from an aqueous dyebath by anionic dyes capable of forming Ni complexes with Ni ions and sealed, the sealing being carried out by a sealing agent comprising boiling water. The dye disclosed in Ciba is a copper complex azo dye containing a nitrogen heterocycle having nitrogen atoms which do not participate in the complex formation, and also containing a sulfonate group, thereby meeting the limitations of claim 5. Ciba does not disclose using nickel ions and fluoride ions in the sealing bath. Clariant is applied as teaching that dyeing aluminum oxide layers with anionic metal complex dyes can be sealed alternatively by steam or boiling water or by preparations comprising nickel and fluoride ions. Clariant states in col 7 that such sealing with metal salts permits particularly effective suppression of dye bleeding giving motivation to seal with nickel salts.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 is dependent on claim 9. A claim can only be dependent on a previous claim.

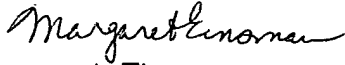
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-

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308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret Einsmann
Primary Examiner
Art Unit 1751

May 8, 2003